

### **REMARKS**

This is a full and timely response to the non-final Office Action of November 7, 2005.

Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Fifth Response, claims 1-5, 8, 10-14, 17, 20, 21, and 23 remain pending in this application. Claims 1, 10, 20, 21, and 23 are directly amended herein, and claim 19 is cancelled without prejudice or disclaimer. Furthermore, amendments to the specification have been submitted herewith. It is believed that the foregoing amendments add no new matter to the present application.

### **Response to Specification Objections**

The specification presently stands objected to in the Office Action for various alleged informalities. Applicants respectfully assert that the specification has been amended herein making these objections moot. Accordingly, Applicants respectfully request that the objections to the specification be withdrawn.

### **Response to Claim Objections**

Claims 1, 10, 20, 21, and 23 presently stand objected to in the Office Action for various alleged informalities. Applicants respectfully assert that claims 1, 10, 20, 21, and 23 have been amended herein making the objections to these claims moot. Accordingly, Applicants respectfully request that the objections to claims 1, 10, 20, 21, and 23 be withdrawn.

### Response to §101 Rejections

Claims 1-5, 8, 10-14, 19, 21, and 22 presently stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. For at least the reasons set forth in the Fourth Response filed on October 6, 2005, Applicants respectfully assert that the pending claims of the instant application are directed to statutory subject matter, and the rejections under 35 U.S.C. §101 are, therefore, improper.

In responding to Applicants' arguments in the Fourth Response, it is asserted in the outstanding Office Action that:

“Claim 1 recites a ‘*first logic*’ (see Line 2) and a ‘*second logic*’ (see line 12). The claim language, when considered as a whole, clearly indicates that the invention of Claim 1 is a computer program (i.e., an algorithm). The claim does not recite that the computer program is tangibly-embodied on a tangible computer-readable medium. Thus, the invention recited in Claim 1 is the algorithm itself. The algorithm alone, without the use of a computer, cannot produce a useful, concrete and tangible result. Accordingly, the subject matter recited in Claim 1 is nonstatutory.

The examiner fails to see how Applicant's argument – that it is well known that logic may be implemented in software or hardware – is relevant to the question of whether Claim 1 recites statutory subject matter.”

Applicants' arguments that “logic may be implemented in hardware or software” refute the premise on which the Office Action bases the 35 U.S.C. §101 rejection. In this regard, in rejecting claim 1 under 35 U.S.C. §101 and attempting to justify the Office Action requirement to add “computer-readable medium” to claim 1, it is asserted in the Office Action that “the claim language, as a whole, clearly indicates that the invention of Claim 1 is a computer program.” However, Applicants traverse this assertion based at least on the fact that the claimed “logic” may be implemented in hardware and/or software, and there is absolutely nothing in claim 1 to suggest that the claimed “logic” can only be implemented in software.

Moreover, the language “configured to” in claim 1 means that the “logic” is arranged to perform the functions recited in this claim. For software embodiments, such an arrangement could be achieved by storing instructions in a computer. For hardware embodiments, an arrangement to perform the claimed functions could be achieved without storing the “logic” on any computer-readable medium. Thus, considering that “configured to” appears in claim 1 and expressly requires the “logic” to be arranged to perform the functions recited by this claim, Applicants assert that claim 1 is statutory. Moreover, the Office Action requirement that Applicants amend the claims to recite the claimed “logic” as residing on a “computer-readable medium” is improper and entirely inconsistent with the manner that the Patent Office has treated similar claim language in other issued patents, as noted in the Fourth Response filed on October 6, 2005.

Further, for similar reasons, Applicants assert that the other claims 2-5, 8, 10-14, 19, 21, and 22 rejected under 35 U.S.C. §101 are statutory as well. Moreover, Applicants respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. §101 rejections of claims 1-5, 8, 10-14, 19, 21, and 22.

#### **Response to §102 Rejections**

“Anticipation under 35 U.S.C. §102 requires the presence in a single prior art disclosure of *each and every* element of the claimed invention.” *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747; 3 U.S.P.Q.3d 1766 (Fed. Cir. 1987).

## Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by <http://web.archive.org/web/19991111161335/http://www.Scriptorium.com/index.html> (hereinafter “*Scriptorium*”). Claim 1, as amended, reads as follows:

1. An apparatus for generating files, the apparatus comprising:
  - a first logic configured to perform a technical writing tool algorithm, the technical writing tool algorithm for receiving input describing a particular selected format and content for a document, the technical writing tool algorithm for processing said input to generate a first markup language file of a first markup language based on an elements file and a plurality of style templates external to said elements file, said elements file defining elements included in said first markup language file and a structure for each of said elements, wherein said first markup language file is printable as a hardcopy document, said first markup language file including first markup language formatting information, said first logic configured ***to define styles of said elements in said first markup language file based on said plurality of style templates, each of said style templates defining a style for a respective one of said elements, said first logic further configured to define a style of one of said elements in said first markup language file and a style of an element in at least one other file of the first markup language based on the same one of said style templates***; and
  - a second logic configured to receive the first markup language file and to perform a conversion algorithm that converts the first markup language file into a second markup language file of a second markup language based on a plurality of mappings for ***mapping said style templates to styles that are to be used in said second markup language file***, wherein said second markup language file includes a second markup language formatting information describing a particular on-line format and content of said document. (Emphasis added).

Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 1 highlighted hereinabove. Therefore, the 35 U.S.C. §102 rejection of claim 1 is improper.

In this regard, it is asserted in the Office Action that *Scriptorium* discloses “because a user may map FrameMaker tags to HTML tags using WebWorks Publisher, the FrameMaker tags are ‘external’ to the Element Definition Document.” Accordingly, it is apparently alleged in the Office Action that the “FrameMaker tags” constitute the “style templates” recited by claim 1. Applicants respectfully disagree. In this regard, a “FrameMaker tag” is not a “template” that can be reused over and over again to define a style for multiple elements and, in particular, multiple elements in different

files. Instead, a “FrameMaker tag” identifies a beginning or end of a particular element. For example, if a paragraph tag is used to mark the beginning of one paragraph, then a new paragraph tag would be created to mark the beginning of another paragraph. Thus, the same “FrameMaker tag” would not be used to define a style for multiple elements in different files.

For at least the above reasons, Applicants respectfully submit that *Scriptorium* fails to disclose at least “first logic” configured to “control a style of one of said elements in said first markup language file and a style of an element in at least one other first markup language file of the first markup language *based on the same one of said style templates*,” as recited by pending claim 1. (Emphasis added). Accordingly, *Scriptorium* fails to disclose all of the features of claim 1, and the 35 U.S.C. §102 rejection of this claim should be withdrawn.

#### **Claims 2-5 and 8**

Claims 2-5 and 8 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Scriptorium*. Applicants submit that the pending dependent claims 2-5 and 8 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-5 and 8 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### Claim 10

Claim 10 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by

*Scriptorium*. Claim 10, as amended, reads as follows:

10. A method for generating files, the method comprising:  
processing input describing a particular desired format and content for a document;  
generating a first markup language file of a first markup language based on said input, an elements file, and a plurality of style templates external to said elements file, said elements file defining elements included in said first markup language file and a structure for each of said elements, wherein said first markup language file is printable as a hardcopy document, said first markup language file including first markup language formatting information, ***said style templates defining styles for said elements included in said first markup language file; controlling a style for a particular one of said elements based on one of said style templates;***  
***controlling a style of an element in at least one other file of the first markup language based on said one style template;*** and  
converting the first markup language file into a second markup language file of a second markup language based on a plurality of mappings for ***mapping said style templates with styles that are to be used in said second markup language file,*** wherein said second markup language file includes second markup language formatting information that describes a particular on-line format and content of said document when it is placed on-line. (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1,

Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 10

highlighted above. Accordingly, the U.S.C. §102 rejection of claim 10, as amended, is improper and should be withdrawn.

### Claims 11-14, 17 and 19

Claims 11-14, 17 and 19 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Scriptorium*. Applicants submit that the pending dependent claims 11-14, 17, and 19 contain all features of their respective independent claim 10. Since claim 10 should be

allowed, as argued hereinabove, pending dependent claims 11-14, 17, and 19 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Claim 20**

Claim 20 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by

*Scriptorium*. Claim 20, as amended, reads as follows:

20. A computer program for generating files, the computer program embodied on a computer-readable medium, the computer program comprising:  
a first algorithm, the first algorithm processing input describing a particular desired format and a content for a document to generate a first markup language file of a first markup language based on an elements file and a plurality of style templates external to said elements file, said elements file defining elements included in said first markup language file and a structure for each of said elements, wherein said first markup language file is printable as a hardcopy document, said first markup language file including first markup language formatting information, ***each of said style templates defining a style for a respective one of said elements, the first algorithm controlling a style of one of said elements in said first markup language file and a style of an element in at least one other file of the first markup language based on the same one of said style templates***; and  
a second algorithm, the second algorithm converting the first markup language file into a second markup language file of a second markup language based on a plurality of mappings, each of said mappings for ***mapping a respective style template with a respective style for said second markup language file***, wherein said second markup language file includes second markup language formatting information that describes a particular on-line format and content of said document when it is placed on-line. (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1,

Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 20

highlighted above. Accordingly, the U.S.C. §102 rejection of claim 20, as amended, is improper and should be withdrawn.

## Claim 21

Claim 21 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by

*Scriptorium*. Claim 21, as amended, reads as follows:

21. An apparatus for generating files, comprising:

a first logic configured to generate a first markup language file of a first markup language based on an elements file and a plurality of style templates separate from said elements file, said elements file defining elements included in said first markup language file and a structure for each of said elements, ***each of said style templates mapped to a corresponding one of said elements and defining a style for said corresponding element***, wherein said first markup language file has formatting information based on at least one of said style templates mapped to at least one of said elements included in said markup language file, and ***wherein the first logic is further configured to control a style of one of said elements in said first markup language file and a style of an element in at least one other file of the first markup language based on the same one of said style templates***; and

a second logic configured to convert the first markup language file into a second markup language file of a second markup language based on a plurality of mappings, each of said mappings for ***mapping a respective style template to a respective style that is to be used in said second markup language file***. (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1,

Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 21

highlighted above. Accordingly, the U.S.C. §102 rejection of claim 21, as amended, is improper and should be withdrawn.



### Claim 23

Claim 23 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by

*Scriptorium*. Claim 23, as amended, reads as follows:

23. A method for generating files, comprising:
- storing an elements file defining markup language file elements and a structure for each of said elements;
  - maintaining a plurality of style templates separate from said elements, each of said style templates mapped to at least a respective one of said elements and defining a style for said one element;
  - generating a first markup language file of a first markup language based on said elements file and at least one of said style templates that is mapped to at least one of said elements included in said first markup language file, said first markup language file having formatting information based on said at least one style template;
    - controlling a style for said at least one element in said first markup language file based on one of said style templates;***
    - controlling a style of an element in at least one other file of said first markup language based on said at least one style template;***
  - converting said first markup language file into a second markup language file of a second markup language based on said elements file and a plurality of mappings for ***mapping said style templates to styles that are to be used in said second markup language file***, wherein one of said mappings maps said at least one style template to a style that is to be used in said second markup language file for said at least one element; and
  - displaying an image of a document defined by said second markup language file. (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1,

Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 23

highlighted above. Accordingly, the U.S.C. §102 rejection of claim 23, as amended, is improper and should be withdrawn.

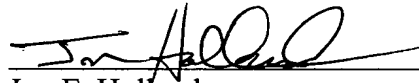
### **CONCLUSION**

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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